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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/511,029

10/11/2004

Emmett M. Partain III

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The Dow Chemical Company  
Intellectual Property Section  
P.O. Box 1967  
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EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

03/03/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/511,029 | <b>Applicant(s)</b><br>PARTAIN III ET AL. |  |
|                              | <b>Examiner</b><br>Paul Marcantoni   | <b>Art Unit</b><br>1793                   |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-13, 15-18 and 20-26 is/are pending in the application.
- 4a) Of the above claim(s) 3, 8, 10-13, 15-18 and 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-7 and 20-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

The applicants' 1/31/08 amendment and response has been considered. Applicants' fully removed all reference to i) a cationically modified or a secondary or tertiary amino modified cellulose ether as a result of examiner's prior art reading upon that aspect of their invention. Applicants now limit their claims to the ii) cellulose ether. The applicants' amendment of claim necessitated the withdrawal of one reference and the application of a newly cited reference in the rejection below:

Withdrawn Claims:

Applicants are respectfully requested to cancel all non-elected claims. Claims 3, 8, and 24 all depend upon cellulose ether i) (cationic cellulose ether) which has been canceled. The claims directed to cellulose ether alone are not rejoinable with the cement + cellulose ether composition. It is noted that applicants in their 9/19/07 response to the restriction requirement elected Group I, claims 1-8 and 20-24 without traverse. Applicants are asked to cancel Group II claims (directed to cellulose alone). It is noted that since they elected "without traverse" in their 9/19/07 they have relinquished their right to petition regarding these claims. It is noted that if applicants do not cancel these claims the examiner has the authorization to cancel the Group II claims should he find allowable subject matter. Finally, claims 17 and 18 are potentially rejoinable but they must be of the same or exact scope as the allowed claims. This is in accordance with In re Ochiai that allows for rejoinder of product and process of using claims.

102/103:

Claims 1-2, 4-7 and 20-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shimomura et al. (JP 05213646) or Chatterji et al. (US Patent No. 4,466,837).

*Note: EP 859011 (De Baynast et al.) has been withdrawn as a result of applicants' amendment deleting cationic celluloses.*

Both references teach a cellulose ether with properties overlapping those for applicants instantly claimed invention (see abstract of JP '646 and claims of Chatterji et al. respectively). Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art.

Response:

Applicants state that Shimomura et al. teach a cellulose ether having the ethylene oxide molar substitution (MS<sub>hydroxyethoxyl</sub>) and percentage of unsubstituted anhydroglucose units. The examiner respectfully disagrees. MS number values for applicants instant invention and Shimomura do overlap. Further, anhydroglucose units are already present in cellulose as part of its structure and the degree of substitution in Shimomura indicates there is overlap of applicants' instantly claimed range in their claims.

Further, applicants appear to argue process limitations which have no bearing on the product to be made. It makes no difference whether or not the hydroxyethoxyl component is introduced by applicants in two or more stages versus what it is assumed by applicants a different method of making so long as the final product is the same. "Product by Process claims do not patentably distinguish the product of reference even

though made by a different process.” In re Thorpe , 227 USPQ 964. It should also be noted that even if Thorpe applies applicants are not claiming these process limitations and it is improper to argue (two or more stages) process limitations not present in their instant claims.

The applicants also argue their instant cellulose composition has a low degree of retardation (for cement). In rebuttal, if the prior art teaches the same composition, the same properties would have been expected to be also the same.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-

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1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Marcantoni/  
Primary Examiner, Art Unit 1793